

Attorney Docket No.: DEX-0109
Inventors: Macina et al.
Serial No.: 09/700,769
Filing Date: January 4, 2001
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REMARKS

Claims 1-6 are pending in the instant patent application. Claims 1-6 have been rejected. Claims 1-6 have been canceled. New claim 7 has been added. Support for claim 7 can be found in the canceled claims and in the teachings of the specification at page 5. Thus, no new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Finality of Restriction Requirement and Objection to Claims

The Examiner has made final the Restriction Requirement mailed October 2, 2003. Thus, the Examiner has object to claim 6 containing rejected to non-elected inventions.

Thus, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to be drawn to the elected subject matter.

In light of the finality of this Restriction Requirement, Applicants reserve the right to file a divisional application to the canceled subject matter.

II. Rejection of Claims 1-5 under 35 U.S.C. § 112, first paragraph

Claims 1-5 have been rejected under 35 U.S.C. § 112, first

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paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skill in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner has acknowledged the written description of the specification to set forth a CSG as mRNA SEQ ID NO:3. However, the Examiner suggests that application is not entitled, nor is the specification enabled for the use of all variants, analogs and derivatives encompassed by the broad term CSG.

It is respectfully pointed out, however, that claims 1-6 have been canceled. Subject matter of these claims is represented in new claim 7 no longer drawn to any CSG but rather drawn specifically to SEQ ID NO:3. Claim 7 is clearly supported by the written description of the instant specification.

Thus, withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

III. Rejection of Claims 1-6 under 35 U.S.C. § 112, second paragraph

Claims 1-6 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests

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that recitation of CSG is indefinite. Further, the Examiner suggests that recitation of "levels of CSG" is indefinite because it is not clear if the CSG to be measured is a polynucleotide, polypeptide or mRNA.

Accordingly, in an earnest effort to advance the prosecution of this case, claims 1-6 containing reference to CSG and levels of CSG have been canceled and replaced with new claim 7 drawn to detecting colon cancer by measuring levels of a polynucleotide comprising SEQ ID NO:3 or native protein encoded by SEQ ID NO:3.

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph is therefore respectfully requested.

IV. Rejection of Claims 1-5 under 35 U.S.C. § 102(e) and 102(b)

Claims 1-5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,733,748.

Claims 1-5 have also been rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/39419.

It is respectfully pointed out, however, that claims 1-5 have canceled, thus mooted these rejections.

Further, new claim 7 is drawn to SEQ ID NO:3, originally presented in claim 6 and not included in either of these rejections.

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Withdrawal of these rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(e) is therefore respectfully requested.

V. Provisional Rejection of Claims 1-5 under 35 U.S.C. § 101

Claims 1-5 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 2-6 of copending Application No. 10/276,115.

It is respectfully pointed out, however, that claims 1-5 have been canceled, thus mooted this rejection.

Further, new claim 7 is drawn to SEQ ID NO:3, originally presented in claim 6 and not included in this rejection.

Withdrawal of this rejection under 35 U.S.C. § 101 is therefore respectfully requested.

VI. Obviousness-type Double Patenting Rejection of Claim 1

Claim 1 has been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/618,596.

It is respectfully pointed out, however, that claim 1 has been canceled, thus mooted this rejection.

Further, new claim 7 is drawn to SEQ ID NO:3, originally presented in claim 6 and not included in this rejection.

Withdrawal of this rejection is therefore respectfully

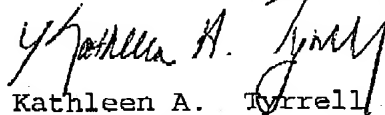
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requested.

VII. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Communication of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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